

***Remarks***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 2-34 are pending in the application, with claims 2, 18, and 19 being the independent claims. Claims 2, 3, 10, 18, 19, 20, and 27 have been amended. Support for these amended claims can be found at page 3, lines 17-26 of the specification of the application of the present invention, for example.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider and withdraw all outstanding objections and rejections.

***I. Objections to the Specification***

The Examiner has advised Applicants to provide the serial numbers and statuses of the patent applications cited in the "Cross-Reference to Other Applications" section of the application of the present invention. *See* Office Action, at page 2. After reviewing this section of the application, Applicants have confirmed that each of the listed patent applications has both a serial number and a status listed, with the exception of provisional application number 60/128,408. Provisional application number 60/128,408 has a serial number listed but not a status. Thus, Applicants have amended the specification to reflect the inactive status of this provisional application.

**II.     *Objections to the Claims***

The Examiner has objected to claims 3, 10, 18, 20 and 27 due to the recited acronym "SIC" in the claims. *See* Office Action, at page 2. As advised by the Examiner, Applicants have amended these claims to include the term represented by the acronym "SIC."

**III.    *Double-patenting Rejection***

The Examiner has rejected claims 2-34 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-32 of co-pending U.S. Patent Application No. 09/564,828. *See* Office Action, at page 3. As advised by the Examiner, Applicants have submitted a terminal disclaimer herewith in compliance with 37 C.F.R. § 1.321(c) to overcome the provisional rejection based on nonstatutory double patenting.

**IV.     *Rejections Under 35 U.S.C. § 103***

Claims 2-34 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,721,910, issued to Unger *et al.* ("Unger") in view of an article by Narin *et al.* (Narin) entitled, "Technological Performance Assessments Based on Patents and Patent Citations." *See* Office Action, at page 5. Applicants respectfully traverse the rejection below as significant technical differences exist between the references and the present invention.

The present invention is a method and system for assisting in various stages of Research and Development (R&D) projects. The classic view of the Research and Development (R&D) process may have five sequential stages. *See Application*, page 3, lines 18 - 20. The process proceeds in sequential fashion until the final stage is reached. For example, in the classic view of the R&D process, the Idea Stage is the first stage. The second stage is typically not entered until the Idea Stage is exited.

At least one tool is associated with one or more tasks of the sequential stages of a particular R&D project. Each of the plurality of tools is associated with one or more tasks of the various stages of the R&D project. Thus, a toolbox comprising the tools is accessed, a task is selected, a tool applicable to the selected task is invoked, and the selected task is performed using the invoked tool. For example, one of the tools associated with the Idea Stage is a topographic map tool. In the Idea Stage, one of the tasks associated with the topographic map tool is displaying a map of patent abstracts which identifies related materials, processes, and uses to consider when expanding and refining an idea in the idea stage. *See Application*, page 16, lines 20-27. Thus, the topographic map tool can create a graphical representation of the above mentioned data to provide the user or company with a visual indication.

In contrast, Unger is a multi-dimensional database that models a business, scientific, or technical body of work. In Unger, the database is designed such that each level of data in the database represents a different level of data abstraction. For example, the data at level one of the database is the least abstract level in the database. The data

at level two in the database is more abstract than the data at level one of the database, etcetera. *See* Unger, column 4, lines 58-61.

In Unger, patents and/or technical documents are assigned to one or more categories within a hierarchical subject model. *See* Unger, column 2, lines 58-65. The database of Unger disaggregates a set of patents and/or technical documents into discrete categories by using a set of pre-defined search protocols which match scientific or technical concepts within the subject model. *See* Unger, column 3, lines 9-12. The set of patents and/or technical documents represents data at level one of the database, the least abstract layer. *See* Unger, column 5, lines 3-6. Unger states that the database also includes a mathematical method of deriving more abstract concepts from the set of stored categorized assignments of patents and/or technical documents. *See* Unger, column 10, lines 33-44.

Unlike the present invention, Unger does not teach a plurality of tools associated with one or more tasks of the sequential stages of an R&D project. Rather, Unger teaches data abstraction levels. There is no sequential execution of stages in Unger. Unger states that the database abstraction levels merely pertain to the design of the database, not a particular process such as R&D. *See* Unger, column 4, lines 57-59.

Narin describes an approach to corporate technological performance assessment, based on patent citation analysis. Narin reviews patent citation analysis and describes five different ways of formatting patent data for performance assessment. *See* Narin,

Abstract. Unlike the present invention, however, Narin does not specifically relate to the R&D process.

The above-mentioned technical differences are reflected in each of the newly amended independent claims of the present invention. For example, independent claim 2 recites, "A computer-implemented method for facilitating sequential stages of a research and development project." Independent claims 18 and 19 recite similar language.

Applicants also disagree with the Examiner's comments in the Office Action. On page 6 of the Office Action, for example, the Examiner states that "...Unger discloses...selecting a task associated with one or more of the stages of the research and development project" as a stage III through VI that represent the database design." Applicants respectfully submit that the stages of the present invention represent sequential stages of a process, namely R&D. Unger's stages are merely levels of data abstraction in the design of the database, not sequential stages of a process. Further, Applicants also submit that the Examiner's assertion that Narin "provides interesting marketing and licensing capability and licensing analyses, wherein the focus is upon the patents as a measure of technological dominance or process" has no bearing on how Narin relates to the R&D process. *See* Office Action, at page 6.

For at least the above reasons, Applicants respectfully submit that amended independent claims 2, 18, and 19 are clearly patentable over Unger in view of Narin.

Further, dependent claims 3-17 and 20-34 are allowable for at least the reasons described above with respect to their associated independent claims, and further in view of their own respective features. Therefore, withdrawal of the rejection is respectfully requested with respect to these claims.

Thus, Applicants submit that a *prima facie* case of obviousness has not been established. Neither Unger nor Narin alone or in combination with one another teaches the claimed features of the present invention. Further still, there is no suggestion or motivation in Unger, Narin, or in the knowledge generally available to one of ordinary skill in the art, to modify Unger. *See* MPEP § 2142.

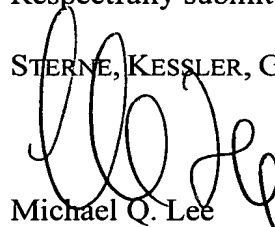
### ***Conclusion***

All of the stated grounds of objection and rejection have been properly traversed, or accommodated. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections, and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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**Version with markings to show changes made**

***In the Specification:***

Text has been added at page 1, line 11.

***In the Claims:***

2. (Once Amended) A computer-implemented method for facilitating sequential stages of a research and development project, comprising the steps of:
  - (1) accessing a tool box comprising a plurality of tools wherein each of said tools is associated with one or more tasks of the sequential stages of the research and development project;
  - (2) selecting a task associated with one of the sequential stages of the research and development project;
  - (3) invoking a tool from said tool box applicable to said selected task; and
  - (4) performing said selected task using said invoked tool.
3. (Once Amended) The method of claim 2, wherein step (3) comprises at least one of the steps of:
  - invoking a tool for generating a topographic map;
  - invoking a tool for generating a top company table;
  - invoking a tool for generating a top inventor table;
  - invoking a tool for generating an inventors by company table;



invoking a tool for generating a features grouping chart;  
invoking a tool for generating a technology classification;  
invoking a tool for generating a [SIC] Standard Industrial Codes classification;  
invoking a tool for generating a patent count/year chart;  
invoking a tool for generating an application count/year report;  
invoking a tool for generating a technology by company map;  
invoking a tool for generating a patent citation tree;  
invoking a tool for generating a nested patent citation tree;  
invoking a tool for generating a product/patent/revenue table;  
invoking a tool for generating a patent/months to issue report; and  
invoking a tool for generating document annotation.

10. (Once Amended) The method of claim 2, wherein one of the stages is a preliminary assessment stage, and said selected task is related to searching a group of patents, dividing said group into subgroups according to technology classification, and mapping said technology classification to its related [SIC] Standard Industrial Codes classification, and wherein said invoked tool generates a [SIC] Standard Industrial Codes classification, wherein said [SIC] Standard Industrial Codes classification provides information to a user to locate markets which should be assessed.

18. (Once Amended) A computer-implemented method for facilitating sequential stages of a research and development project, comprising the steps of:

(1) accessing a tool box comprising a plurality of tools wherein each of said tools is associated with one or more tasks of the sequential stages of the research and development project;

(2) selecting a task associated with one of the sequential stages of the research and development project, said task comprising at least one of the tasks of:

searching a group of patents;

searching a group of company documents;

searching a group of patents and dividing said group into subgroups according to technology classification;

searching a group of patents, dividing said group into subgroups according to inventor, and dividing said subgroups according to assignee;

searching a group of patents, dividing said group into subgroups according to technology classification, and mapping said technology classification to its related [SIC] Standard Industrial Codes classification;

searching a group of patents and performing a forward citation on each of said patents to create a patent citation tree;

searching a group of patents and performing a specified number of forward citations on each of said patents to create a nested patent citation tree;

searching a group of patents, dividing said group into subgroups according to patent classification, and dividing said subgroups according to assignee;

searching a group of patents and documents and sorting said group according to product attributes;

searching a group of patents, sorting said group by a period of time field, and performing calculations relating to said field; and

searching a group of patents and documents and annotating said patents and documents;

- (3) invoking a tool from said tool box applicable to said selected task; and
- (4) performing said selected task using said invoked tool.

19. (Once Amended) A computer-implemented system for facilitating sequential stages of a research and development project, comprising:

- (1) a computer based tool box comprising a plurality of tools wherein each of said tools is associated with one or more tasks of the sequential stages of the research and development project;
- (2) means for invoking a tool from said tool box to perform a selected one of said tasks; and
- (3) means for performing said selected task using said invoked tool.

20. (Once Amended) The system of claim 19, wherein said tool box comprises at least one of:

- a tool for generating a topographic map;
- a tool for generating a top company table;
- a tool for generating a top inventor table;
- a tool for generating an inventors by company table;
- a tool for generating a features grouping chart;
- a tool for generating a technology classification;
- a tool for generating a [SIC] Standard Industrial Codes classification;
- a tool for generating a patent count/year chart;
- a tool for generating an application count/year report;
- a tool for generating a technology by company map;
- a tool for generating a patent citation tree;
- a tool for generating a nested patent citation tree;
- a tool for generating a product/patent/revenue table;
- a tool for generating a patent/months to issue report; and
- a tool for generating document annotation.

27. (Once Amended) The system of claim 19, wherein one of the stages is a preliminary assessment stage, and said selected task is related to searching a group of patents, dividing said group into subgroups according to technology classification, and mapping said technology classification to its related [SIC] Standard Industrial Codes classification, and wherein said invoked tool generates a [SIC] Standard Industrial Codes classification, wherein said [SIC] Standard Industrial Codes classification provides information to a user to locate markets which should be assessed.